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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/587,459

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Patrice Robert

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EXAMINER

JACOBSON, MICHELE LYNN

ART UNIT

PAPER NUMBER

1794

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/587,459	Applicant(s) ROBERT ET AL.	
	Examiner MICHELE JACOBSON	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 4-9 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 6,528,587.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant application recite the binder composition recited in U.S. Patent No. 6,528,587. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have utilized this binder composition to adhere polymer layers as recited in the instant application.

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3. Claims 4-9 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3-10 and 12-15 of copending Application No. 10/671758. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications claim structures comprising EVOH/tie layer/PET wherein the properties recited for the tie layer are the same. The tie layer claimed in the instant application also encompasses the more specific embodiments claimed in Application No. 10/671758.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Objections

4. Claim 4 is objected to because of the following informalities: The amendment submitted on 7/16/09 to correct the range within a range limitations in claim 4 inadvertently deleted the units (g/10 minutes) for the range of melt flow index for the polyethylene homopolymer or copolymer. The claims will be interpreted to recite this unit but appropriate correction is required.

5. Claims 8 and 9 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiply dependent claim. See MPEP § 608.01(n). Generally, the claims would not be further treated on the merits, however, since the amendment to the claims submitted 1/9/09 had previously corrected the multiple dependencies in the originally filed claims, claims 8

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and 9 will be interpreted to comprise the limitations submitted 1/9/09. Any amendments to the claims submitted in the future should be appropriately marked to reflect corrections made to the claims submitted 7/16/09.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 4-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robert et al U.S. Patent Application Publication No. 2001/0053821, now U.S. Patent No. 6,528,587 B2 used herein for reference (hereafter referred to as Robert) and Dupont et al. U.S. Patent No. 5,101,064 (hereafter referred to as Dupont).

8. Robert teaches a coextrusion tie (coextrusion binder; column 1, lines 7 - 9) which comprises polymer (A) which comprises 5 to 35% by weight of a polymer (A1) itself composed of a blend of 80 to 20% by weight of a metallocene polyethylene with a density of between 0.865 and 0.915 g/cm³ and 20 to 80% by weight of a non - metallocene LLDPE polyethylene (A2) with a density between 0.900 and 0.950 g/cm³ (column 3, lines 7 - 9); the blend of polymers being co-grafted by an unsaturated carboxylic acid, the content of the grafting monomer in the blend being between 600

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and 5,000 ppm, and 95 to 65% by weight of a polyethylene (B), the total therefore forming 100%, the blend of the polymers being such that its melt flow index is between 1 and 13 g/10 min. (column 1, lines 39-60)

9. The tie layer is recited to be useful in multilayer structures as an adhesive to bind together layers comprising polymers such as EVOH and polyester. (column 2, lines 7-14) These multilayer structures are recited to be useful for manufacturing flexible or rigid packaging, such as sachets, bottles of containers by methods that include coextrusion-blow molding

10. Robert is silent regarding the polyethylene homopolymer (B) having a melt flow index of between 0.5 and 30 g/10 min. However, Robert discloses that the melt flow index of the polyethylene homopolymer which is selected must produce a blend having a melt flow index of between 0.1 and 10 g/min (the blend has a melt flow index of between 0.1 and 10 g/min; column 1, lines 51 - 52).

11. Therefore, one of ordinary skill in the art would have recognized the utility of varying the MFI of the polyethylene homopolymer (B) to obtain the desired recited MFI of the blend. Therefore, the MFI of the blend would be readily determined through routine optimization of the MFI of the polyethylene homopolymer (B) by one having ordinary skill in the art depending on the desired use of the end product as taught by Robert et al. The obvious optimization of the MFI of the polyethylene homopolymer (B) would have produced a coextrusion tie layer composition as recited in claim 4. It would have been obvious to one having ordinary skill in the art at the time the invention was

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made to use this composition to produce a container comprising EVOH/tie layer/polyester layer as disclosed by Roberts.

12. Robert is silent regarding the use of glycolised copolyester such as PETG as the polyester composition to be adhered with the tie layer composition recited.

13. The examiner takes official notice that PETG is a polyester compound well known in the art to find utility in bottle making applications as evidenced by Dupont which states "Terephthalate polyester resins like PET, CPET, PETG, PBT and PCT are thermoplastic polymers which are widely used in the plastics industry. PET and PETG are used in the manufacturing of film, bottles and plastic containers of all kinds". (column 1, lines 34-39)

14. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have utilized PETG as the polyester resin for manufacturing a multi-layer structure such as a bottle comprising EVOH/optimized tie layer of Roberts/PETG since PETG is widely used in the bottle making industry. The obvious use of PETG in such a coextruded blow molded multi-layer bottle as recited by Robert would have produced the invention as claimed in claims 4-9.

Response to Arguments

15. Applicant's arguments filed 7/16/09 have been fully considered but they are not persuasive.

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16. Applicant has asserted on pages 4 and 5 of the remarks that while they do not dispute that PET and PETG have been used to make bottles, however, "there is no teaching or suggestion from Dupont or Robert to use a glycolized polyester such as PETG as the polyester composition to be adhered with the tie layer composition claimed" and that "there is also no motivation in the art to combine the teachings of Robert and Dupont". The examiner is not persuaded by these arguments since Dupont clearly states, as conceded by applicant, that PET and PETG are widely used to make bottles. "In *United States v. Adams*, . . . [t]he Court recognized that when a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result." *KSR*, 550 U.S. at ___, 82 USPQ2d at 1395. In the instant case, substituting PETG for the generic polyester recited in Robert yields the predictable result of producing a bottle.

17. Applicant has asserted on page 5 of the remarks that one of ordinary skill would not "expect any advantage over the prior art" by substituting PETG for PET and that there is no suggestion of the desirability of this combination or that the transparency or adhesion of the end use article would be better. However, applicant has not recited any limitations of transparency or adhesion. Applicant's assertion that the prior art must explicitly state an advantage of the claimed combination is not found persuasive in light of the finding as shown by the prior art that the invention claimed by applicant is the result of a mere substitution of elements known in the field.

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18. As such, the provisional double patenting rejection over USPN 6,528,587 is maintained since it would have been obvious to one having ordinary skill in the art at the time the invention was made to have utilized this binder composition to adhere polymer layers as recited in the instant application.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHELE JACOBSON whose telephone number is (571)272-8905. The examiner can normally be reached on Monday-Thursday 8:30 AM-7 PM EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on (571)272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michele L. Jacobson
Examiner /M. J./
Art Unit 1794

/Rena L. Dye/
Supervisory Patent Examiner, Art Unit 1794